

JUN 08 2009

Application Serial No: 10/533,150

Responsive to the Notice of a Non-Compliant Amendment mailed on: April 6, 2009

**REMARKS**

This Response is in response to the Notice of Non-Compliant Amendment mailed on April 6, 2009. Claims 1-3 and 5-12 are pending.

**Examiner Interview:**

Applicants thank the Examiner, Ms. Natalia Levkovich, for the telephonic interview that took place on April 17, 2009 with the Applicants' representative Amol Kavathekar regarding the Examiner's constructive election of species made in the Notice of Non-Compliant Amendment of April 6, 2009. In the interview, the Examiner noted that under rule 37 CFR 1.142(b) and in light of MPEP 821.03, the constructive election of species of original claims 1-12 is proper. However, Applicants' representative noted that 37 CFR 1.142(b) and MPEP 821.03 is directed to a requirement for restriction of two or more independent and distinct inventions and not to a requirement for an election of species, governed under rule 37 CFR. 1.146. Applicants' representative also noted that rule 37 CFR 1.146 states that "[i]n the first action on an application containing a generic claim to a generic invention (genus) and claims to more than one patentably distinct species embraced thereby, the examiner may require the applicant in the reply to that action to elect a species of his or her invention to which his or her claim will be restricted if no claim to the genus is found to be allowable". Accordingly, since original claims 1-12 were examined without requiring Applicants to elect a species in the Office Action on the merits mailed on July 8, 2008, the Examiner's constructive election of claims 1-12 is improper. No agreement was reached.

**Response to the Notice of Non-Compliant Amendment:**

The Notice asserts that claims 1-3 and 5-12 as presented in the Amendment of January 8, 2009 is directed to an invention that is independent or distinct from the invention of the original claims.

Applicants respectfully assert that the constructive election of original claims 1-12 is improper. Original claim 1 and amended claim 1 are both directed to an analyzing tool. Also, originally filed claim 1 is broad enough in scope to cover features discussed, for example, on page 9, lines 23-24; page 12, line 18-page 14, line 2; page 13, lines 11-

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22; and in Figures 2 and 4-7. Further, the amendments to claim 1, supported, for example, in the portions of the disclosure listed above, did not remove any features of original claim 1, but merely further defined the invention of claim 1 by including additional structural features of the analyzing tool of original claim 1. As such, Applicants respectfully assert that amended claim 1 is not directed to an invention that is independent or distinct from the invention of original claim 1.

Further, rule 37 CFR 1.146 states that "[i]n the first action on an application containing a generic claim to a generic invention (genus) and claims to more than one patentably distinct species embraced thereby, the examiner may require the applicant in the reply to that action to elect a species of his or her invention to which his or her claim will be restricted if no claim to the genus is found to be allowable". Original claims 1-12 were examined without requiring Applicants to elect a species in the Office Action on the merits mailed on July 8, 2008. Moreover, rule 37 CFR 1.142(b) and MPEP 821.03 are directed to a requirement for restriction of two or more independent and distinct inventions and not to a requirement for an election of species, governed under rule 37 CFR. 1.146. Accordingly, rule 37 CFR 1.142 and MPEP 821.03 allow an examiner to make a constructive restriction requirement of two independent and distinct claims after a first action, but do not allow a requirement for an election of species after a first action or a constructive election of species. Accordingly, Applicants respectfully request the withdrawal of the Notice of Non-Compliant Amendment and proper examination of claims 1-3 and 5-12 as presented in the Amendment of January 8, 2009.

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Conclusion:

Applicants respectfully assert that claims 1-3 and 5-12 are appropriate for examination and are in condition for allowance. If a telephone conference would be helpful in resolving any issues concerning this communication, please contact Applicants' primary attorney-of record, Douglas P. Mueller (Reg. No. 30,300), at (612) 455-3804.

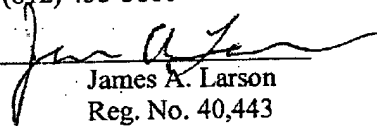


Dated: June 8, 2009

Respectfully submitted,

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